

**II. REMARKS**

As an initial matter, Applicants traverse the Examiner's determination that the Office Action of September 30, 2008 be made "FINAL" (See Office Action, dated September 30, 2008, at 16, lines 10-13). Specifically, the Examiner's grounds for rendering a "final" Office Action is that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action" (Office Action, dated September 30, 2008, at 16, lines 10-11). However, the Examiner's grounds for rendering a "final" Office Action are erroneous because Applicants' "Reply (C) After Final," filed August 25, 2008, did not amend the claims. Therefore, the Examiner's new grounds of rejection were not necessitated by amendment and the "finality" of the Office Action of September 30, 2008 is premature.

**For all of the above reasons, the Examiner's "finality" determination of September 30, 2008 is premature and should be withdrawn.**

Applicants gratefully acknowledge the Examiner's determination that claims 32 and 40 contain allowable subject matter (Office Action, dated September 30, 2008, at 16, lines 5-8).

By the present amendment, claims 32 and 40 have been cancelled without prejudice, claims 23, 27 and 28 have been amended, and new claims 46 and 47 have been added. Specifically, claims 23, 27 and 28 have been amended to improve grammar and clarity, and not for a reason related to patentability. Therefore, the present amendment has no further limiting effect on the scope of claims 23, 27 and 28.

New independent claim 46 incorporates subject matter from previous claims 23, 30, 31 and 32, and corresponds to previous claim 32 rewritten in independent form. Therefore, claim 46 has the same scope as previous claim 32.

New independent claim 47 incorporates subject matter from previous claims 23 and 40, and corresponds to previous claim 40 rewritten in independent form. Therefore, claim 47 has the same scope as previous claim 40.

The present amendment adds no new matter to the above-captioned application and raises no new issues.

**A. The Invention**

The present invention pertains broadly to a watch provided with an additional function besides indicating the time. In accordance with an embodiment of the present invention, a watch is provided that includes features recited by independent claim 23. In accordance with another embodiment of the present invention, a watch is provided that includes features recited by independent claim 27. In accordance with yet another embodiment of the present invention, a watch is provided that includes features recited by independent claim 28. In accordance with still another embodiment of the present invention, a watch is provided that includes features recited by independent claim 46. In accordance with another embodiment of the present invention, a watch is provided that includes features recited by independent claim 47. Various other embodiments, in accordance with the present invention, are recited by the dependent claims.

An advantage of the various embodiments of the present invention is that a watch is provided that operates in a time mode to indicate time and also operates in a second operating mode to monitor a physical magnitude and to indicate value(s) of the physical magnitude in a third operating mode. Depending on the embodiment of the present invention, the physical magnitude may, for example, pertain to information relating to a depth, altitude, altitude variation speed, a magnetic field and an ambient temperature.

**B. The Rejections**

Claims 23, 25, 27-31, 33-39 and 41-43 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Plancon et al. (US Patent 7,113,450, hereafter the “Plancon Patent”).

Applicants respectfully traverse the Examiner’s rejection and request reconsideration of the above-captioned application for the following reasons.

**C. Applicants’ Arguments**

New independent claims 46 and 47 incorporate allowable subject matter from previous claims 32 and 40, respectively. Therefore, new claims 46 and 47 are allowable for the reasons of record.

**i. The Section 103 Rejection**

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation, or other legitimate reason, for combining the references in the manner claimed. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739-41 (2007); In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In this case, the Examiner has failed to establish a prima facie case of obviousness against the claimed invention because (i) the Plancon Patent fails to teach each and every limitation of the claimed invention, (ii) the Examiner has not established a legitimate reason to justify modifying the apparatus disclosed by the Plancon Patent in the manner asserted by the Examiner, and (iii) the Examiner has failed to demonstrate that a person of ordinary skill in the art would have had a reasonable

expectation of success of arriving at Applicants' claimed invention even if the modification asserted by the Examiner was made.

**ii. The Plancon Patent**

The Plancon Patent discloses a "wearable electronic device with multiple display functionality" as shown in Figure 1, wherein the wearable electronic device is used to convey information in an analog manner at least in part by the use of at least one display hand positioned on the dial side of a dial, wherein the wearable electronic device uses the display hand(s) to convey information that is stored in the controller of the device and/or provided by sensors and/or an external transmitter (See Abstract of the Plancon Patent). According to the Plancon Patent, an actuation mechanism, such as a stepper motor, is used to rotate the display hands in the clockwise and/or counterclockwise directions in predefined increments to convey the information (See Abstract of the Plancon Patent). As would be immediately appreciated by a person of ordinary skill in the art, the devices disclosed by the Plancon Patent include an analogue display that has an hour hand (18), a minute hand (20), and a second hand (21) for indicating time and additional hands, such as 4<sup>th</sup> hand (22) and dash1 hand (24) for displaying stored information or information collected by sensors (Plancon Patent, col. 7, lines 3-19, col. 7, line 61, to col. 8, line 4, and col. 11, lines 37-54, and Figure 1). As evident from Figures 5, 6, 8A, 8B, 8C, 8D, 9A, 9B, 10, 11 and 13, all of the embodiments disclosed by the Plancon Patent employ conventional hands (18), (20) and (21) for displaying time information and an additional set of hands (22) and (24) for displaying information stored by the watch or collected by sensors of the watch.

In other words, the Plancon Patent does not teach, or even suggest, using the conventional hands (18), (20) and (21) to display both time information in a first operating mode and information collected by a sensor, or information stored by the watch, using the

conventional hands (18), (20) and (21) in another operating mode. Therefore, the Plancon Patent does not teach, or even suggest

“at least first and second analogue display members, wherein the analogue display members are arranged above the dial to display current time in a time mode...a historic mode that is a third operating mode in which the processing means are arranged for generating control signals to be sent to the motor means for a display representative of stored values of the physical magnitude as a function of time so that at least said first analogue display member indicates, opposite suitable graduations of the watch, the value of a variable, the change in which is linked to physical magnitude value on condition that the variable does not give any indication relating to time...”

as recited by independent claims 23, 27 and 28. The Examiner even repeatedly concedes this deficiency in the disclosure of the Plancon Patent (Office Action, dated April 21, 2008, at 3, lines 20-22; and Office Action, dated September 30, 2008, at 4, lines 3-5). Thus, the Plancon Patent also does not teach, or suggest, “said second analogue display member is made to indicate information relating to a depth” as recited by independent claims 23, 27 and 28.

### **iii. The Examiner’s Official Notice**

The Examiner now contends that the subject matter previously alleged by the Examiner to be disclosed by U.S. Patent Application Publication No. US 2004/0047242 (hereafter, the “Germiquet Publication”) is well-known in the art and takes “Official Notice” of these alleged facts (See Office Action, dated September 30, 2008, at 4, lines 6-17; at 7, lines 4-15 ; at 9, line 19, to at 10, line 9; at 10, line 20, to 11, line 10; at 13, lines 9-20 ; at 14, lines 11-22 ; and etc.). The Germiquet Publication is not valid prior art for the purposes of determining patentability under 35 U.S.C. § 103(a). To the extent that the Examiner is replacing the disclosure of the Germiquet Publication with an “Official Notice,” Applicants object.

Applicants remind the Examiner that the Administrative Procedure Act requires that the Examiner’s rejections employ “reasoned decision making” based on evidence from a fully

developed administrative record. In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002).

Patentability determinations that are based on what the Examiner believes is “basic knowledge” and “common sense,” and that otherwise lacks substantial evidentiary support, are impermissible. In re Zurko, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). In this case, the Examiner’s transparent attempt to replace the teachings of the Germiquet Publication with an “Official Notice” lends, on its face, to the conclusion that the subject matter of the “Official Notice” is not common knowledge in the art. Therefore, Applicants respectfully traverse the Examiner’s Section 103 rejection of claims 23, 27, 28, 29, 37 and 38 on the grounds that the “Official Notice(s)” lack(s) “substantial evidentiary support.” Therefore, the Examiner must now adduce substantial evidentiary support (e.g., produce a prior art reference) with respect to the subject matter claimed, or withdraw the Section 103 rejection standing against claims 23, 27, 28, 29, 37 and 38.

#### **iv. No Legitimate Reason to Modify the Apparatus Disclosed by Plancon**

A proper rejection under Section 103 further requires showing (1) that a person of ordinary skill in the art would have had a legitimate reason to attempt to make the composition or device, or to carry out the claimed process, and (2) that the person of ordinary skill in the art would have had a reasonable expectation of success in doing so. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007). In this case, the Examiner has adduced no legitimate reason to modify the apparatus disclosed by the Plancon Patent to arrive at Applicants’ claimed invention.

As admitted by the Examiner (Office Action, dated April 21, 2008, at 3, lines 20-22; and Office Action, dated September 30, 2008, at 4, lines 3-5), the Plancon Patent does not teach, or suggest, first and second analog display means that display both time information in one operating mode, and physical magnitude information in another operating mode. In

accordance with the present invention, the same hands are used to display both the current time and stored/measured physical magnitude values, wherein there are (i) “at least [two] analogue display members, wherein the [two] analogue display members are arranged above the dial to display current time in a time mode” and (ii) “at least said first analogue display member indicates...the value of a variable, the change in which is linked to physical magnitude value” in the historic mode as recited by independent claims 23, 27 and 28. Thus, in accordance with independent claims 23, 27 and 28, “at least said first analogue display member” is used in the historic mode for the “display representative of stored values of the physical magnitude as a function of time.” The benefits of such a solution are to provide a more intuitive reading as described on page 3, line 15+, of Applicant’s specification.

In contrast, the Plancon Patent discloses a wearable electronic device provided with a set of “display hands” (22), (24), (26) that are in addition to the conventional hour, minute and second hands (18), (20), and (21), respectively (See Figure 1 of the Plancon Patent). As disclosed in col. 11, lines 50-57, of the Plancon Patent, the additional display hands (22), (24) and (26) are employed for the display of values of data collected by the various sensors (120a), (120b), (120c) for altitude, body temperature and heart rate monitoring, respectively, whereas the analogue hands (18), (20) and (21) are used to indicate time (See also Plancon Patent, col. 10, line 61, to col. 11, line 23). The Plancon Patent simply does not disclose any embodiment wherein the time indicating hands (18), (20) and (21) are used to indicate a physical magnitude.

In view of the above facts, not only does the Plancon Patent fail to teach, or even suggest, using the time indicating hands (18), (20) and (21) to indicate a physical magnitude, but the Plancon Patent actually teaches away from using the time indicating hands (18), (20) and (21) to indicate physical magnitude data because Plancon repeatedly discloses using time indicating hands (18), (20), (21) for no other mode other than the time indicating mode. In

view of the above facts, it is apparent that the Examiner is impermissibly deriving both (i) the reason for making a watch wherein time indicating hands are used both for indicating time in one mode and for displaying physical magnitude information in another mode, and (ii) the reasonable expectation of success in so doing, from Applicants' disclosure and not from prior art. In re Vaeck, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

The Examiner erroneously contends that the Plancon Patent discloses a "historic mode" that is used to display stored values of the physical magnitude at col. 22, lines 26-36 (Office Action, dated September 30, 2008, at 3, lines 10-20). However, the Examiner's contention is flawed because the Plancon Patent discloses, at col. 22, lines 22-36, that the replay mode deals with physical exercise events and related measurements, such as heart rate and blood pressure, but never with "physical magnitudes" such as environmental pressure or temperature as defined at page 1, lines 17-19, of Applicants' original specification. Although the Plancon Patent discloses at col. 23, lines 8-18, that a wide range of parameters, such as, e.g., water pressure, could be measured with other sensors, the Plancon Patent does not teach, or suggest, maintaining a historical mode for these other parameters (i.e., including physical magnitude measurements). In addition, because safety purposes completely elude the disclosure of the Plancon Patent, a person of ordinary skill in the art would have absolutely no reason to apply Plancon's "memory mode" to physical magnitude parameters, such as depth, altitude, altitude variation speed, magnetic field and ambient temperature parameters, to help determine what happened in case of an accident. The present invention, on the other hand, may use the historic mode to determine what happened in an accident (See, e.g., Applicants' specification, at 3, lines 24-27, which describes using the historic mode to analyse a diving accident).

In sum, the Examiner has failed to establish a legitimate reason, based on prior art, to modify the apparatus disclosed by the Plancon Patent so as to employ the hands used for

indicating time for the purposes of indicating time in one operational mode and for indicating physical magnitude data in another operational mode. Consequently, the Examiner has failed to establish a prima facie case of obviousness against Applicants' claimed invention.

#### **v. No Reasonable Expectation of Success**

A proper rejection under Section 103 further requires showing that the person of ordinary skill in the art would have had a reasonable expectation of success of achieving Applicants' claimed invention if the modifications asserted were made. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007). In this case, the Examiner has failed to show that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at Applicants' claimed invention if the modifications asserted by the Examiner were made.

Specifically, the Federal Circuit has ruled that a reference must be enabling in order to serve as prior art. In re Donohue, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). In this case, the Plancon Patent does not teach or suggest a watch wherein the conventional time indicating hands are used to indicate time in one operational mode and are also used to indicate a physical magnitude in another operational mode as conceded by the Examiner (Office Action, dated September 30, 2008, at 4, lines 3-5). Because the Plancon Patent is completely silent with respect to a watch having such a feature, the Plancon Patent is not enabling for such a device. More specifically, the Plancon Patent provides absolutely no guidance regarding how to make such a device, and the Plancon Patent provides absolutely no working examples regarding such a device; therefore, undue experimentation would be required to make such a device based on the Plancon Patent's disclosure. See, e.g., Impax Laboratories, Inc. v. Aventis Pharmaceuticals Inc., 545 F.3d 1312, 1314-16 (Fed. Cir. 2008). Therefore, the Plancon Patent is not enabling for such a watch as recited by independent claims 23, 27

and 28. Id. The Examiner's unsubstantiated "Official Notice" fails to make up this deficiency.

In view of the above facts, the Examiner has failed to demonstrate that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at Applicants' invention, as recited by independent claims 23, 27 and 28, even if the modifications asserted by the Examiner as desirable were made because undue experimentation would be required to effect the modifications asserted by the Examiner. Therefore, the Examiner has, for all of the above reasons, failed to establish a prima facie case of obviousness against Applicants' claimed invention.

### **III. CONCLUSION**

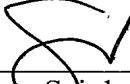
Independent claims 46 and 47 contain allowable subject matter, and are in condition for allowance for the reasons of record. With respect to independent claims 23, 27 and 28, the Examiner has failed to establish a prima facie case of obviousness against these claims based on the Plancon Patent because, as admitted by the Examiner, the Plancon Patent fails to teach, or suggest, each and every limitation of the claimed invention. Furthermore, the Examiner has failed to adduce a legitimate reason, grounded in the prior art and not on Applicants' disclosure, for modifying the watch disclosed by the Plancon Patent so that its time indicating hands are used to indicate time in one operational mode and to indicate a physical magnitude in another operational mode. The Examiner has also failed to demonstrate that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at Applicants' claimed invention based on modification of the subject matter of Plancon Patent, which is not enabling prior art with respect to a watch that employs time hands for displaying both time and physical magnitude information.

For the reasons stated above, claims 23, 25, 27-31, 33-39, 41-43, 46 and 47 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

The below-signed attorney for Applicants welcomes any questions.

Respectfully submitted,

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